

REMARKS

By the August 21, 2003 Office Action, claim 6 has been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention; claims 1, 2, 4, 5, 12, 13, 15, 17, 19, 20, 21 have been rejected under 35 U.S.C. §102(b), as allegedly being anticipated by *Graber et al.*, U.S. Patent No. 5,162,986; claims 1, 2, 4-7, 12, 13, 15-22 have been rejected under 35 U.S.C. §102(e), as allegedly being anticipated by *Stripf et al.*, U.S. Patent No. 6,263,487; claims 3, 14, and 23 have been rejected under 35 U.S.C. §103(a), as allegedly being unpatentable over *Stripf et al.*; and claims 8-11 have been rejected under 35 U.S.C. §103(a), as allegedly being unpatentable over *Graber et al.* in view of *Deegan et al.*, U.S. Patent No. 6,055,632.

By this Amendment, the Specification and Claims have been amended to overcome the rejections.

Amendments to the Specification

The Specification has been amended to provide the continuation-in-part application number noted on page 1 and to correct various informalities.

Claim Rejections under 35 U.S.C. § 102

Applicant's amended independent Claims 1, 12, 17, and 21 are directed to a control system of an automation network. The control system includes an operably connected automation device and a network device. The network device includes an application program for controlling the automation device. The automation device transmits a network address request to the network device. In response to the network address request, an application program is provided to the automation device from the network device.

Such a capability provides for utilizing a readily available PLC for convenient insertion within an automation network wherein a PLC's physical location within the network determines the functionality required of the PLC. Thus, a suitable application program — based partially or completely on the PLC's physical location within the automation network — can be quickly provided to any readily connected controller for implementation within the automation network.

Preferably, the network device is a server capable of storing one or more application

programs and thus reduces or eliminates the need for the automation device to store its own application programs. The application program includes an executive code and a user code, and each can be created or edited using the network device without requiring the resources of the automation device.

Contrastingly, *Graber et al.* is directed to transferring a program between a programming terminal and an I/O module through a programmable controller system processor. There is no disclosure within *Graber et al.* denoting an application program being available to an automation device in response to a request for a network address from the automation device. Furthermore, there is no disclosure within *Graber et al.* suggesting such a capability or its desired benefit.

Similar to *Graber et al.*, *Stripf et al.* also fails to disclose an application program for an automation network being transmitted in response to a request for a network address. *Stripf et al.* discloses a globally distributed automation network wherein a control program comprises object-oriented software function blocks that facilitate the loading of the control program while it is executing. However, *Stripf et al.* fails to teach, disclose, or suggest transmitting an application program from a network device to an automation device in response to a network address request from the automation device. Additionally, *Stripf et al.* further fails to disclose or suggest the desirability of such an attribute.

In order for a reference to act as a § 102 bar to patentability, the reference must teach each and every element of the claimed invention. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983). Because *Graber et al.* and *Stripf et al.* fail to disclose each and every element of Applicant's claimed invention, Applicant submits that the 102 rejections of pending independent claims 1, 12, 17, and 21 have been obviated in view of the above amendments and remarks. Thus, Applicant submits that the independent claims, as amended, are allowable and respectfully request the rejections be removed.

Claims 2-11, 13-16, 18-20, and 21-23 are dependent, directly or indirectly, on Claims 1, 12, 17, and 21, respectively; and thus contain each limitation of Claims 1, 12, 17, and 21. Therefore, based on at least the same reasons given for allowance of Claims 1, 12, 17, and 21, Applicants respectfully request that claims 2-11, 13-16, 18-20, and 21-23 be allowed.

Claim Rejections under 35 U.S.C. § 103

As shown above, *Stripf et al.* fails to disclose each and every element of Applicant's independent claims, as amended. Furthermore, *Stripf et al.* fails to disclose, teach, or suggest each and every element of Applicant's amended independent claims. As such, *Stripf et al.* fails to render obvious Applicant's claimed invention.

Similarly, *Graber et al.* also fails to disclose each and every element of Applicant's independent claims, as amended. *Graber et al.* further fails to disclose, teach, or suggest each and every element of Applicant's amended independent claims. As such, *Graber et al.* fails to render obvious Applicant's claimed invention.

Deegan et al. discloses a system and method for transferring firmware to a programmable controller system from a remote computer. However, the addition of *Deegan et al.* does not overcome the deficiencies of the teaching of *Graber et al.* — namely, providing an application program from a network device to an automation device in response to a network address request from the automation device.

To properly combine prior art references, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination of references feasible. This knowledge cannot come from the Applicant's invention itself. See *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79 (Fed. Cir. 1988)); *In re Geiger*, 815 F.2d 686, 687 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147 (Fed. Cir. 1985). "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (citing *In re Gormyan*, 933 F.2d 900, 902 (Fed. Cir. 1984)).

Certainly, this rationale is applicable in the present case. *Graber et al.* discloses transferring a program between a programming terminal and an I/O module through a programmable controller system processor; and *Deegan et al.* discloses a system and method for transferring firmware to a programmable controller system from a remote computer. There is no reason, suggestion, or motivation within each cited reference to combine or modify the teaching of either reference in view of the other. Thus, combination of the *Stripf et al.* and *Deegan et al.*

is improper as there is no motivation in the references to combine them. *See In re Napier*, 55 F.3d 610, 613, 34 U.S.P.Q.2d 1782, 1785 (Fed. Cir. 1995).

Moreover, even if *Graber et al.* and *Deegan et al.* are allowed to be combined, the inclusion of *Deegan et al.* fails to overcome the deficiencies of *Graber et al.* to render obvious Applicant's claimed invention. Therefore, because neither *Graber et al.* nor *Deegan et al.*, alone or in combination, disclose, teach, or suggest Applicant's claimed invention, as amended, Applicant submits that the claims are patentable over the cited prior art and respectfully requests the removal of the rejections.

CONCLUSION

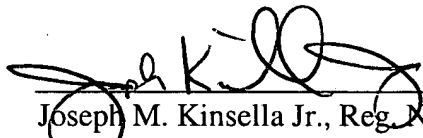
In view of the amendments and remarks above, Applicant submits that the Application is in condition for allowance. Applicant respectfully requests the Examiner to withdraw the rejections and allow the claims to issue. If any deficiencies remain and it would expedite the progress of this Application through the examination process, the Examiner is invited to call Michael Femal, Esq. at (847) 925-3452.

Although Applicant does not believe any fees are associated with this Response, the Commissioner is hereby authorized to charge deposit account 19-3875(SAA-34-2) for any fees associated herein.

Respectfully submitted,

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By:



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